

REMARKS

Claims 1-3, 9-11 and 14-16 have been amended. Claims 17-33 have been cancelled. Claims 1-16 and 34-38 are pending in the case.

In this Response, Applicants have cancelled claims 17-33 from further consideration in this application. Applicants are not conceding that the subject matter encompassed by claims 17-33 is not patentable. Claims 17-33 were cancelled in this Response solely to facilitate expeditious prosecution of the remaining claims. Applicants respectfully reserve the right to pursue additional claims, including the subject matter encompassed by claims 17-33, as presented prior to this Response in one or more continuing applications.

Claim Rejections Under 35 U.S.C. 102(e)

Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by US Application Publication No. 2005/0038750 to *Cahill* et al., (hereinafter "*Cahill*"). Applicants respectfully traverse these rejections.

For ease of discussion, claim 1 is discussed first. Claim 1, directed to a method, calls for (1) determining that a user is authorized to receive less than all of an electronic mail message based on at least one digital right associated with the electronic mail message, (2) reducing the electronic mail message by removing the unauthorized portion but retaining at least a portion of the electronic mail message that the user is authorized to receive and (3) providing the reduced electronic mail message to the user. By allowing a user to download content the user is authorized to receive, the electronic mail system is more secure and may adhere to digital property protection laws more ardently. Additionally, by pairing this authorization feature with the ability to download reduced resolution versions of email, a user's data transfer rate may be accommodated at the same time.

The Examiner argues that *Cahill* anticipates claim 1. The Examiner's rejection fails, however, because *Cahill* does not teach at least one of the claimed features. For example, *Cahill* does not teach the first claimed feature of determining that a user is authorized to receive less than all of an electronic mail message. The Examiner argues that this feature is taught by *Cahill* because it discloses the "rights managed email" with "controlled rendering of arbitrary forms of digital content, where such control is flexible and definable." See Final Office Action, p.4; see also *Cahill*, ¶[0189]. The Examiner's reliance on *Cahill*, however, is misplaced because *Cahill* does not teach determining whether a user is authorized to receive less than all of the email; rather, this reference describes the user receiving an *entire* e-mail. In particular, *Cahill* describes how rights management (RM) email is achieved for an entire email or document that is sent to a user who must use the proper decryption key to open the electronic content. In *Cahill*, an *entire* email and its content is encoded, encrypted, or signed with a digital key, and the user must obtain the proper key to read the email. See *Cahill*, ¶[0189] & [0128] (stating that a user who receives an email/document but cannot obtain an appropriate license will not be able to render the email/document). As such, contrary to the Examiner's assertion, *Cahill* does not teach determining that a user is authorized to receive less than all of an electronic mail message based on at least one digital right associated with the electronic mail message, as called for by claim 1.

Additionally, *Cahill* fails to teach the claimed feature of reducing the electronic mail message by removing the unauthorized portion but retaining at least a portion of the electronic mail message that the user is authorized to receive. The Examiner argues that this feature is taught in *Cahill*. See Final Office Action, p.5. In particular, the Examiner asserts that an RM server issues a license to an approved user who in turn will receive an email with protected/encrypted content and a message in the "main info" section 48 of the email. See

Cahill, ¶0099, lines 6-19, ¶0089, lines 12-22, ¶0091, lines 1-22 & Fig. 6 (stating that the message in section 48 is generically addressed to an unauthorized user and informs the unauthorized user that the email is protected and has protected content; this message can be discarded if the user is an authorized user). This teaching in *Cahill*, however, fails to teach the claimed feature of removing the unauthorized portion for at least the following reasons.

As can be seen from the teaching of *Cahill*, the discarded content is not an unauthorized portion of the email. To the contrary, the discarded message in *Cahill* is actually specifically designed to be *unprotected content* (i.e., authorized to everyone) so that even a user without any access rights is able to read it and discern the message's contents (i.e., notice that there is protected content that is off limits to such a user). The passage in *Cahill* relied upon by the Examiner is directly contrary to the teachings of claim 1. Claim 1 calls for, among other things, reducing the electronic mail message by removing the unauthorized portion but retaining at least a portion of the electronic mail message that the user is authorized to receive. *Cahill* shows discarding a portion of an email that is not unauthorized for any user, and as such, *Cahill* fails to teach this claimed feature.

Cahill also fails to teach the claimed feature of providing the retained portion of the electronic mail message to the user in the reduced electronic mail message. The Examiner argues that this feature is taught by *Cahill*, and in particular, that an email is encrypted and compressed by a first user and sent to a second user who decompresses and decrypts the email (assuming the second user has the appropriate rights). See Final Office Action, p.6; see also *Cahill*, ¶[0096]. The Examiner's reliance on *Cahill*, however, is misplaced because the Examiner has attempted to equate the claimed feature of a reduced electronic mail message with the "compressed content" teaching of *Cahill*. The differences in these two ideas are clear. The

claimed feature is removing unauthorized content from the email and providing the remaining content to the user (*i.e.*, the content of the electronic email is actually reduced because data is removed). *Cahill*, on the other hand, does not remove any unauthorized content at all; the content is compressed. In other words, the *size* of the email content is reduced by compression, but when the content in *Cahill* is decompressed, the entirety of the email content will be present. In contrast, claim 1 calls for reducing an electronic mail message by removing the unauthorized portion.

For at least the aforementioned reasons, claim 1 is allowable. Applicants respectfully submit that claims 2-16, being dependent from claim 1, are also allowable for similar reasons as claim 1.

Claim 3 is also allowable for additional features recited therein. Claim 3, which depends from claim 1, calls for (1) determining that the user is authorized to receive less than all of the electronic mail message comprises accessing at least one of a user input and a user profile, (2) providing to the user information relating to at least one portion of content of the electronic mail message, (3) providing to the user information relating to the unauthorized portion, wherein the unauthorized portion is associated with at least one protected content indicator, (4) receiving, from the user, at least one preference for reducing the electronic mail message, (5) wherein reducing comprises reducing based upon the preference received from the user, wherein the preference refers to a reduced resolution version of the electronic email message and a transfer criteria associated with downloading of the electronic mail message, (6) wherein providing the reduced electronic mail message includes providing using trickle downloading and (7) wherein the reduced electronic mail message includes an attachment, wherein the digital right is

associated with the attachment, and wherein providing the reduced electronic mail message includes providing less than all of the attachment based on the associated digital right.

The Examiner's rejection of claim 3 fails because *Cahill* fails to teach several of the claimed features. For example, *Cahill* does not teach determining that the user is authorized to receive less than all of the electronic mail message comprises accessing at least one of a user input and a user profile. The Examiner suggests that this feature is taught in *Cahill* by the disclosure of a user entering commands and information (a user entering in his/her "login ID," accessing emails and creating user profiles, according to the Examiner). See Final Office Action, p.8; see also *Cahill*, ¶0048, lines 1-23, ¶0050, lines 1-14 & ¶0051, lines 1-18. The Examiner's reliance on *Cahill* is misplaced for at least the following reasons.

First, as discussed above with respect to claim 1, *Cahill* fails to teach the claimed feature of determining that the user is authorized to receive less than all of the electronic mail message. As such, *Cahill* cannot teach all the claimed features of claim 3.

Second, with respect to the claimed feature of reducing comprises reducing based upon input choices made by the user, wherein reducing based upon user input choices comprises retaining a reduced resolution version of the portion of the electronic email message in response to determining the user has selected at least one portion of email content that the user is authorized to access, and wherein reducing comprises reducing the electronic mail message based on transfer criteria, *Cahill* is silent. By allowing a user to decide to receive or not receive authorized portions of the electronic message, a user is allowed flexibility within the authorized content allowed. Additionally, by reducing the message based on transfer criteria, reduction may be dynamically accomplished to adapt to changes in the network environment.

With respect to the claimed feature of providing to the user information relating to at least one portion of content of the electronic mail message, *Cahill* is silent. Similarly, *Cahill* does not teach providing to the user information relating to the unauthorized portion, wherein the unauthorized portion is associated with at least one protected content indicator, as called for in claim 3. Additionally, the claimed feature of receiving, from the user, at least one preference for reducing the electronic mail message is not disclosed in *Cahill*. *Cahill* also fails to teach reducing comprises reducing based upon the preference received from the user, wherein the preference refers to a reduced resolution version of the electronic email message and a transfer criteria associated with downloading of the electronic mail message. *Cahill* is also silent with respect to providing the reduced electronic mail message includes providing using trickle downloading. The claimed feature of the reduced electronic mail message includes an attachment, wherein the digital right is associated with the attachment, and wherein providing the reduced electronic mail message includes providing less than all of the attachment based on the associated digital right is neither taught nor suggested by *Cahill*. As such, *Cahill* does not, and cannot, teach all the claimed features of claim 3.

For at least the aforementioned reasons, claim 3 and its dependent claims are allowable.

Claim 9 is also allowable for additional features recited therein. Claim 9, which depends from claim 1, calls for (1) determining a format associated with the electronic mail message in response to determining that the user is authorized to receive less than all of the electronic mail message, (2) reducing the electronic mail message comprises reducing based on at least the determined format and (3) reducing comprises determining a format of at least one file associated with the electronic mail message. By allowing certain formats of electronic mail and

attachments to be authorized or unauthorized, a user's access to specific content may be more closely controlled.

The Examiner's rejection of claim 9 fails because *Cahill* fails to teach several of the claimed features. For example, *Cahill* does not teach that reducing the electronic mail message comprises reducing based on at least the determined format. *Cahill* teaches that any format of email or attachment *may be encrypted* and that a content owner may decide who is allowed access to such content. See Final Office Action, p.11; *Cahill*, ¶¶[0065],[0067] & [0142]. In other words, *Cahill* describes that any electronic mail content may be encrypted prior to sending the entire electronic mail message to a user, and if the user has been granted the proper license, she may open the email and view its contents. *Cahill*, however, does not teach that a format associated with the electronic mail message is a factor in reducing the electronic mail message. In fact, *Cahill* teaches, and the Examiner agrees, that electronic content is encrypted regardless of the format or type. See *id.* (explaining that a rights management system allows controlled rendering of *arbitrary* content), emphasis added. In contrast, claim 9 calls for reducing based on at least the determined format.

The Examiner's rejection also fails because *Cahill* does not teach the claimed feature of reducing comprises determining a format of at least one file associated with the electronic mail message. As discussed immediately above, *Cahill* teaches, and the Examiner agrees, that electronic content is encrypted regardless of the format or type. As such, *Cahill* does not, and cannot, teach the claimed feature of reducing comprises determining a format of at least one file associated with the electronic mail message, as called for in claim 9 of the instant Application.

For at least the aforementioned reasons, claim 9 is allowable. For similar reasons, claims depending from claim 9 are also allowable.

Claim 34 is also allowable for additional features recited therein. Claim 34, a method, calls for interfacing with a user of a computer system having a graphical user display, comprising (1) displaying at least one indicator of a digital rights management rule associated with at least one portion of at least one electronic mail message, (2) monitoring the position and selection status of a pointer controller to detect that at least one of the at least one indicators has been selected by the user and (3) providing an indication of a user authorization associated with the at least one portion of the at least one electronic mail message and the digital rights management rule in response to detecting that at least one of the at least one indicators has been selected by the user.

The Examiner's rejection fails because *Cahill* does not teach at least one of the claimed features. For example, *Cahill* does not teach the claimed feature of displaying at least one indicator of a digital rights management rule. The Examiner argues that *Cahill* teaches licensing rules associated with an email must be satisfied before protected digital content can be displayed on a user's computing device. See Final Office Action, p.17-18; *Cahill*, ¶¶[0068],[0093]. *Cahill*, teaches that a digital content owner may specify RM rules associated with content/attachments that will be included in an email. This requires a user to have the appropriate decryption key or license to gain access to the email content. *Cahill* does not disclose displaying at least one indicator of a digital rights management rule, as called for in claim 34.

Cahill also fails to teach the claimed feature of monitoring the position and selection status of a pointer controller. The Examiner argues this claimed feature is taught by *Cahill*. See

Final Office Action, p.18. In particular, the Examiner argues that *Cahill* teaches that a trusted component mechanism evaluates license rules and requirements using a license evaluator. See *id.*; *Cahill*, ¶¶[0068]-[0070]. This section of *Cahill* teaches that license rules and requirements are compared to user credentials in order to determine if a user is allowed to view certain protected content, but *Cahill* does not, however, disclose any teachings regarding monitoring the position and selection status of a pointer controller. In fact, *Cahill* is silent with respect to this claimed feature, and the Examiner has failed to point to any teaching or suggesting of this feature. As such, *Cahill* does not, and cannot, teach the claimed feature of monitoring the position and selection status of a pointer controller, as called for in claim 34.

Cahill also fails to teach the claimed feature of at least one indicator has been selected by the user. As discussed above, *Cahill* does not teach that the at least one indicator is ever displayed to the user. As such, *Cahill* cannot teach that at least one indicator has been selected by the user.

For at least the aforementioned reasons, claim 34 is allowable. For similar reasons, claims depending from claim 34 are also allowable.

Applicants respectfully assert that in light of the amendments and arguments provided herein, all claims of the present application are now allowable and, therefore, request that a Notice of Allowance be issued.

Reconsideration of the present application is respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the Houston, Texas telephone number (713) 934-4064 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON, P.C.
CUSTOMER NO. 23720

Date: August 29, 2008

By: /Ruben S. Bains/
Ruben S. Bains, Reg. No. 46,532
10333 Richmond, Suite 1100
Houston, Texas 77042
(713) 934-4064
(713) 934-7011 (facsimile)
ATTORNEY FOR APPLICANT(S)